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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,060	12/02/2003	David S. Benco	LUC-452/Benco 49-37-37-45	2645
32205	7590	09/09/2005	EXAMINER	
PATTI & BRILL ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			SMITH, SHEILA B	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,060

Applicant(s)

BENCO ET AL

Examiner

Sheila B. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-27 is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Jennings et al.

U.S Patent Number 6,597,774.

Regarding claim 1, Jennings et al. discloses essentially all the claimed invention as set forth in the instant application, further Jennings et al. discloses a system and method for providing an alert during communication. In addition Jennings et al. discloses a method for automatically notifying, by a telecommunications network, a subscriber that the subscriber has talked on a mobile terminal for a subscriber-defined amount of time (which reads on column 1 lines 41-46), the method comprising the steps of: defining an interval for at least one category of usage of a mobile terminal that is operatively connected to a telecommunication network; storing, at the telecommunication network (which reads on column 3 lines 46-57), the defined interval for the at least one category of usage of the mobile terminal; monitoring, by the telecommunication network, a time that a call has been active on the mobile terminal (which reads on column 1 lines 56-67); comparing the time that the call has been active to the stored at least one interval; and sending a predetermined notification signal from the telecommunication

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system to the mobile terminal when the time that the call has been active exceeds the stored interval (which reads on column 1 lines 56-67).

Regarding claim 2, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses at least one of the category, the interval and the predetermined notification signal are user-defined via the mobile terminal (which reads on column 3 lines 46-57).

Regarding claim 3, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses after the call has first exceeded the interval, again monitoring a second time that the call has been active on the mobile terminal, and sending another predetermined notification signal from the telecommunication system to the mobile terminal when the second time that the call has been active exceeds the stored interval that is associated with the current applicable category (which reads on column 1 lines 41-67).

Regarding claim 4, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses periodically monitoring the time that the call has been active on the mobile terminal, and sending the predetermined notification signal from the telecommunication system to the mobile terminal upon each occurrence of the time that the call has been active exceeding the stored interval that is associated with the current applicable category (which reads on column 3 lines 46-57).

Regarding claim 5, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the predetermined notification signal comprises at least one of a tone message, a voice message, and a visual message, and wherein each of the tone message,

voice message, and visual message is selectable at the mobile terminal and storable in the telecommunication network (which reads on column 1 lines 41-67).

Regarding claim 6, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses selecting and storing the predetermined notification signal from at least one of a tone message, a voice message, and a visual message, and wherein each of the tone message, voice message, and visual message is selectable at the mobile terminal and storable in the telecommunication network (which reads on column 3 lines 46-57).

Regarding claim 7, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the tone message is at least one of a single tone, a series of tones, a respective one of a plurality of tones that is associated with a respective one of a plurality of intervals associated with consecutive occurrences of times when the call exceeds the stored interval that is associated with the current applicable category (which reads on column 1 lines 41-67).

Regarding claim 8, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the category comprises at least one of daytime minutes, nighttime minutes, peak minutes, weekday minutes, and weekend minutes (which reads on column 3 lines 46-57).

Regarding claim 9, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the method further comprises entering a disable code at the mobile terminal at least during the call, the disable code instructing the telecommunication network to cease sending notification signals (which reads on column 3 lines 46-57).

Regarding claim 10, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses a method for automatically notifying, by a telecommunications network, a subscriber that the subscriber has talked on a mobile terminal for a subscriber-defined amount of time, the method comprising the steps of: defining a plurality of categories of usage of a mobile terminal; defining a respective interval for each category of the plurality of categories of usage of the mobile terminal that is operatively connected to a telecommunication network (which reads on column 1 lines 41-47); storing, at the telecommunication network, the defined intervals and the respectively associated categories of usage; determining for the call a current applicable category of the plurality of categories for the mobile terminal (which reads on column 3 lines 46-57); monitoring, by the telecommunication network, a time that a call has been active on the mobile terminal; comparing the time the call has been active to the stored interval that is associated with the current applicable category; and sending a predetermined notification signal from the telecommunication system to the mobile terminal when the time that the call has been active exceeds the stored interval that is associated with the current applicable category (which reads on column 1 lines 56-67).

Regarding claim 11, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses at least one of the categories, the intervals and the predetermined notification signals are user-defined via the mobile terminal. (which reads on column 1 lines 41-67).

Regarding claim 12, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the method further comprises, after the call has first exceeded the interval, again monitoring a second time that the call has been active on the mobile terminal,

and sending another predetermined notification signal from the telecommunication system to the mobile terminal when the second time that the call has been active exceeds the stored interval that is associated with the current applicable category (which reads on column 3 lines 46-57).

Regarding claim 13, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the method further comprises periodically monitoring the time that the call has been active on the mobile terminal, and sending the predetermined notification signal from the telecommunication system to the mobile terminal upon each occurrence of the time that the call has been active exceeding the stored interval that is associated with the current applicable category (which reads on column 3 lines 46-57).

Regarding claim 14, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the predetermined notification signal comprises at least one of a tone message, a voice message, and a visual message, and wherein each of the tone message, voice message, and visual message is selectable at the mobile terminal and storable in the telecommunication network (which reads on column 1 lines 41-67).

Regarding claim 15, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses selecting and storing a respective predetermined notification signal from at least one of a tone message, a voice message, and a visual message, and wherein each of the tone message, voice message, and visual message is selectable at the mobile terminal and storable in the telecommunication network (which reads on column 1 lines 56-67).

Regarding claim 16, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the tone message is at least one of a single tone, a series of tones, a respective one of a plurality of tones that is associated with a respective one of a

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plurality of intervals associated with consecutive occurrences of times when the call exceeds the stored interval that is associated with the current applicable category (which reads on column 1 lines 41-67).

Regarding claim 17, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses the categories comprises at least one of daytime minutes, nighttime minutes, peak minutes, weekday minutes, and weekend minutes (which reads on column 3 lines 46-57).

Regarding claim 18, Schiffer discloses everything claimed, as applied above (see claim 1) additionally, Schiffer discloses a method further comprises entering a disable code at the mobile terminal at least during the call, the disable code instructing the telecommunication network to cease sending notification signals (which reads on column 3 lines 46-57).

Allowable Subject Matter

1. Claims 19-27 allowed.


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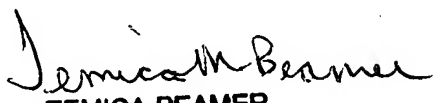
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (571)272-7847. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Smith 
September 6, 2005


TEMICA BEAMER
PRIMARY EXAMINER